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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/359,527 07/22/99 WEBB

P 10990641-1

HM22/0508

EXAMINER

IP ADMINISTRATION
LEGAL DEPARTMENT 20BN
HEWLETT-PACKARD COMPANY
P O BOX 10301
PALO ALTO CA 94303-0890

LUNDGREN, J

ART UNIT	PAPER NUMBER
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1631

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DATE MAILED:

05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/359,527	Applicant(s) WEBB ET AL.	
	Examiner Jeffrey Lundgren	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 February 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 and 46-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-14, 17-19, 49, 51, 52 and 55 is/are allowed.
- 6) Claim(s) 15, 16, 46-48, 50, 53 and 54 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) Interview Summary (PTO-413) Paper No(s) _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The rejection of claim 16 under 35 U.S.C. 112, second paragraph, in the Office Action mailed on October 4, 2000, is maintained for the reasons of record (reiterated below).

Claim 16 recites the limitation "the accuracy in an ability" in the step where a position encoder is used. There is insufficient antecedent basis for this limitation in the claim.

3. The rejection of claims 1-15, and 17-19 under 35 U.S.C. 112, second paragraph, in the Office Action mailed on October 4, 2000, are overcome by means of Applicants' amendments received on February 21, 2001.

New Grounds of Rejection - 35 USC § 112

4. Claims 15, 16, 46-48, 50, 53, and 54, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite for reciting the phrase "an accuracy of the encoder" because the skilled artisan could not reasonably determine the metes and bounds of this limitation. For example, it is not clear which encoder-based parameters this would include.

Claim 16 is indefinite for reciting the phrase "the accuracy in an ability" because the skilled artisan could not reasonably determine the metes and bounds of this limitation.

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Claims 46 and 48 are indefinite for reciting the phrase "an accuracy in an ability" because the skilled artisan could not reasonably determine the metes and bounds of this limitation.

Claim 47 is indefinite for reciting the term "deviation of actual movement" because the skilled artisan could not reasonably determine the metes and bounds of this limitation.

Claim 50 is indefinite for reciting the term "effect of thermal expansion" because the skilled artisan could not reasonably determine the metes and bounds of this limitation. It is not clear how to reasonably determine which effects result from thermal expansion.

Claims 53 and 54 are indefinite for reciting the term "dynamic position" because the skilled artisan could not reasonably determine the metes and bounds of this limitation. For example, it is not clear which positions would be considered dynamic, and which position would not be considered dynamic.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The rejection of claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over Budach et al. (Anal. Chem. 71, 3347-3355, 1999) in view of Suzuki (U.S. Patent No. 4,675,696, June 23, 1987), in the Office Action mailed on October 4, 2000, is overcome for the reasons argued by Applicants in the response received on February 21, 2001.

Conclusion

8. Claims 1-14, 17-19, 49, 51, 52, and 55 are allowable.

9. Any inquiries concerning the *merits* of this communication or earlier communications from the Examiner should be directed to Jeffrey S. Lundgren, whose telephone number is (703) 306-3221. The Examiner can normally be reached on Monday-Friday from 7:00 AM to 5:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Michael Woodward, can be reached at (703) 308-4426.

Any inquiries of a *general* nature relating to this application should be directed to Ms. Pauline Farrier, Patent Analyst for Art Unit 1631, whose telephone number is (703) 305-3550.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed to Group 1631 using (703) 308-0294. Please notify the Examiner of incoming facsimiles prior to sending papers to the aforementioned fax number. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Jeffrey S. Lundgren, Ph.D.

JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER